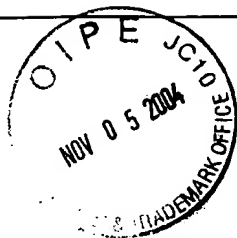


AF/1631  
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November 5, 2004

Mail Stop Appeal Brief – Patents  
Commissioner for Patents  
P.O. Box 1450  
Alexandria, Virginia 22313-1450

Art Unit: 1631  
Examiner: M.L. Borin  
Conf. No.: 7322

Re: U.S. Patent Application Serial No. 09/615,606 filed July 13, 2000  
Inventors: Mark S. ABAD *et al.*  
Title: Nucleic Acid Molecules and Other Molecules Associated with Plants  
Atty Dkt.: 16517.284

Sir:

Transmitted herewith for appropriate action by the U.S. Patent and Trademark Office (PTO) are the following documents:

1. Appellants' Reply Brief; and
2. Return postcard.

It is respectfully requested that the attached postcard be stamped with the date of filing of these documents, and that it be returned to our courier.

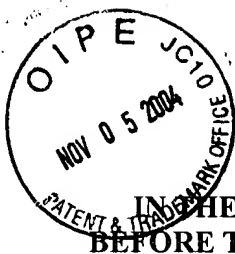
In the event that extensions of time beyond those petitioned for herewith are necessary to prevent abandonment of this patent application, then such extensions of time are hereby petitioned. Appellants do not believe any additional fees are due in conjunction with this filing. However, if any fees are required in the present application, including any fees for extensions of time, then the Commissioner is hereby authorized to charge such fees to Arnold & Porter LLP Deposit Account No. 50-2387, referencing docket number 16517.284. A duplicate copy of this letter is enclosed.

Sincerely,

A handwritten signature in black ink, appearing to read "T. E. Holsten".

Thomas E. Holsten (Reg. No. 46,098)  
David R. Marsh (Reg. No. 41,408)

Enclosures



IN THE UNITED STATES PATENT AND TRADEMARK OFFICE  
BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES

In re application of:

Mark S. ABAD *et al.*

Appln. No.: 09/615,606

Filed: July 13, 2000

For: **Nucleic Acid Molecules and Other Molecules Associated with Plants**

Confirmation No.: 7322

Art Unit: 1631

Examiner: Michael L. Borin

Atty. Docket: 16517.284

**APPELLANT'S REPLY BRIEF**

Mail Stop Appeal Brief – Patent  
Commissioner for Patents  
P.O. Box 1450  
Alexandria, Virginia 22313-1450

Sir:

This is a reply to a new point of argument raised in the Examiner's Answer mailed September 7, 2004 ("Examiner's Answer").

**1. The Examiner's New Points of Argument**

**a. The Rejection Raised Under 35 U.S.C. § 112, first Paragraph**

Under the heading "Response to Argument", the Examiner's Answer alleges that Appellant's Brief filed June 15, 2004 "provides arguments only to the first 'written description' rejection." Examiner's Answer at page 21. Appellant respectfully disagrees. However, Appellant agrees with the Examiner that the asserted written description rejections of record are based on two grounds. His first ground is based on the "comprising" language and the second is premised on the percent identity language of claims 10-13. The Examiner has erred in ignoring statements and in mischaracterizing arguments made in the Appellant's Brief and alleges that Appellant provided arguments

to only the first ground of rejection under 35 U.S.C § 112, first paragraph. The Appellant's Brief, for example, sets forth arguments relating to the disclosure of variations including and directed to the claimed nucleic acid molecules and specifically points to hybridization conditions and site-directed mutagenesis disclosed in the specification. Moreover, Appellant reiterates that the structural features of the nucleotide sequences of SEQ ID NO:2 have been disclosed. This argument applies with equal force to both grounds for the Examiner's written description rejection. The respective structural feature (for example, the nucleotide sequences of SEQ ID NO:2 and variations thereof) is shared by every nucleic acid molecule in the claimed genera, and it distinguishes the members of the claimed genera from non-members. In addition, footnote 12 states that "[t]his argument applies with equal force to every genus of the claimed nucleic acid molecule. For example, if a nucleic acid molecule such as an mRNA, comprises a nucleotide sequence having 95% identity to SEQ ID NO: 2, then it is a member of the genus of nucleic acid molecules having 95% identity to SEQ ID NO: 2. *See*, claim 11." As such, the Examiner's assertion that Appellant has provided arguments only for the first ground is not proper.

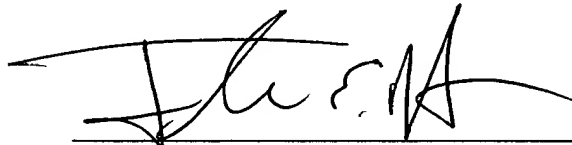
Moreover, the Appellant has pointed out portions of the specification that disclose nucleic acid sequences having the recited sequence identity with SEQ ID NO: 2. *See*, Appellant's Brief filed June 15, 2004 at page 2, under heading 5 "Summary of the Invention." Appellant wishes only to clarify the record on this point and present a correct assessment of the arguments presented in the Appellant's Brief filed June 15, 2004.

Accordingly, claims 1, 8 and 10-13 are supported by an adequate written description, and the rejection should be reversed.

### CONCLUSION

In view of the foregoing, it is respectfully requested that the Board of Patent Appeals and Interferences reverse the Rejections and that the subject application be allowed forthwith.

Respectfully submitted,

A handwritten signature in black ink, appearing to be "T. E. Holsten" followed by "D. R. Marsh", written over a horizontal line.

Thomas E. Holsten (Reg. No. 46,098)  
David R. Marsh (Reg. No. 41,408)

Date: November 5, 2004

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